

REMARKS

Claims 1-11 are all the claims pending in the Application. By this Amendment, Applicant amends claims 1-11 for improved conformity with the US practice. In addition, Applicant adds claims 12-15. Claims 12-15 are clearly supported throughout the specification.

I. Preliminary Matters

The Examiner has approved the drawings filed on September 22, 2003, has acknowledged receipt of the priority document, and has correctly indicated consideration of the Information Disclosure references filed on September 22, 2003.

II. Formal Matters

The Examiner has objected to the title of the invention as being insufficiently descriptive. Applicant respectfully requests the Examiner to withdraw this objection to the title in view of the self-explanatory amendments being made herein.

III. Summary of the Office Action

Claims 1-11 presently stand rejected. Claims 1, 2, and 6-10 are rejected under 35 U.S.C. § 101, claims 1-3 and 7-10 are rejected under 35 U.S.C. § 102(b), and claims 4, 5, and 11 are rejected under 35 U.S.C. § 103(a).

Claim 6 is not rejected over the prior art of record. Accordingly, it appears that claim 6 is allowable provided the rejection under 35 U.S.C. § 101 is overcome.

IV. Claim Rejections under 35 U.S.C. § 101

Claims 1, 2, and 6-10 are rejected under 35 U.S.C. § 101 as allegedly being directed to non-functional descriptive material (*see* page 2 of the Office Action). Applicant respectfully

submits, at the very least, the claims are not directed to a *non-functional* descriptive material as clearly various functions are executed. In addition, claims 1, 2, and 6-8 recite a computer-implemented method¹ and claims 9 and 10 recite a computer-readable medium.² In view of these self-explanatory claim amendments, Applicant respectfully requests the Examiner to withdraw this rejection of the claims.

V. Claim Rejections under 35 U.S.C. § 102

Claims 1-3 and 7-10 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,410,699 to Bealkowski et al. (hereinafter "Bealkowski"). Applicant respectfully traverses this rejection in view of the following comments.

Claim 1 is the only independent claim. Among a number of unique features, claim 1 recites: "a recovery program is executed in the data processing system,...wherein the recovery carried out is non-destructive, and wherein all the features that are characteristic of the data and the system are stored in a control file of the recovery program."

The Examiner alleges that claim 1 is directed to a method of recovering data and is anticipated by Bealkowski. Specifically, the Examiner alleges that a) Bealkowski's recovery mode (col. 3, lines 1 to 7) somehow discloses executing the recovery program, b) Bealkowski's method of updating BIOS on the fixed disk (col. 10, lines 47 to 49) is not destructive, and c)

¹ MPEP § 2106(IV)(B)(1)(a) states: "[w]hen a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim."

² MPEP § 2106(IV)(B)(1)(a) states: "[w]hen a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim."

Bealkowski's method of loading the BIOS image into RAM after a compatibility check discloses a control file of the recovery program having all features that are characteristic of the data and the system stored therein (*see* page 3 of the Office Action). Applicant respectfully disagrees.

To be an "anticipation" rejection under 35 U.S.C. § 102, the reference must teach every element and recitation of the Applicant's claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention.

To begin, Bealkowski does not disclose or suggest "a recovery program," as set forth in claim 1. In Bealkowski, only a recovery mode is provided, in which BIOS (Basic Input/Output System)³ are loaded from a different location (*i.e.*, in the recovery mode, the BIOS are loaded from a diskette and not from a fixed disk). In other words, Bealkowski simply discloses designating a location from where the BIOS are to be retrieved based on the mode and does not disclose or suggest a recovery program being executed. That is, despite the use of the term "recovery," Bealkowski only discloses a method of loading BIOS from an alternate source in the event of a failure to load from a fixed disk. In short, loading the input/output system (BIOS) from a different location when the system is in a recovery mode, as disclosed in Bealkowski, cannot disclose or suggest executing a recovery program, as set forth in claim 1.

³ BIOS - The part of the system software of the IBM PC and compatibles that provides the lowest level interface to peripheral devices and controls the first stage of the bootstrap process, including installing the operating system. The BIOS is stored in ROM, or equivalent, in every PC. Its main task is to load and execute the operating system which is usually stored on the computer's hard disk, but may be loaded from CD-ROM or floppy disk at install time. <http://foldoc.org/foldoc/foldoc.cgi?BIOS>, last visited July 3, 2006.

Moreover, the Examiner alleges that Bealkowski in column 10, lines 47-49 discloses a non-destructive recovery method. Col. 10, lines 47-49 of Bealkowski, to the contrary, recite: “[t]hus the new BIOS image, included on diskette, can be given to the user to update the BIOS image on the fixed disk.” That is, Bealkowski only discloses that a new BIOS image, included on diskette, can be given to the user to update the BIOS image on the fixed disk. If one BIOS image is used to update (modify, change) another BIOS image, clearly then, the method is destructive *i.e.*, one image is being used to modify another image. In short, Bealkowski does not disclose or suggest recovering data in a non-destructive manner.

Furthermore, the Examiner also asserts that Bealkowski discloses that all the features that are characteristic of the data and the system are stored in a control file of the recovery program, citing column 3, lines 19-22 and column 7, lines 16-19 of Bealkowski (*see* page 3 of the Office Action). However, col. 3, lines 19-22 of Bealkowski only disclose that the BIOS may be stored on a diskette. Col. 7, lines 16-19 of Bealkowski only disclose that after a compatibility check, the executable code loads the BIOS image into RAM. That is, Bealkowski does not disclose that all the features that are characteristic of the data and the system are stored in a control file.

Bealkowski only discloses storing the BIOS in a fixed disk and in an alternative location such as a diskette. In fact, in Bealkowski, there is no disclosure of a control file of the recovery program, and especially, there is no disclosure or suggestion of a control file that stores all the features that are related to the data and the system.

In view of the above, Applicant respectfully submits that independent claim 1 is patentably distinguishable from Bealkowski. Therefore, Applicant respectfully requests the

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Examiner to withdraw this rejection of the independent claim 1. Claims 2-3 and 7-10 are allowable at least by virtue of their dependency on claim 1.

VI. Claim Rejections under 35 U.S.C. § 103 Rejection

Claims 4, 5, and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bealkowski in view of U.S. Publication No. 2002/0087877 to Grawrock (hereinafter "Grawrock"). Applicant respectfully traverses this rejection in view of the following comments.

Claims 4, 5, and 11 depend on claim 1. It was already demonstrated that Bealkowski does not disclose or suggest all of the unique features of claim 1. Grawrock does not cure the deficient disclosure of Bealkowski. Accordingly, claims 4, 5, and 11 are patentable at least by virtue of their dependency on claim 1.

Furthermore, a person of ordinary skill in the art would not have had motivation to combine Grawrock and Bealkowski. The Examiner asserts that there is motivation to combine the two references because Grawrock discloses using the encryption of data to protect the integrity of the data being transferred and that this is an explicit desire of Bealkowski (*see* page 5 of the Office Action). Bealkowski, however, discloses the use of a password to prevent all users except for trained engineers from loading the BIOS image from diskette, to ensure the integrity of the operation of the system, by causing the system to be loaded only with the correct configuration of the BIOS image on the fixed disk. That is, Bealkowski is not concerned with the integrity of the data itself; rather, Bealkowski is concerned that an untrained user may compromise the integrity of the system by loading an incorrect configuration of the BIOS image. A person of ordinary skill in the art would not have been motivated to combine the encryption technique of Grawrock with the disclosure of Bealkowski.

Furthermore, the Examiner is exercising impermissible hindsight in an attempt to combine the references. Bealkowski's disclosure is directed to an apparatus and method for loading BIOS from a diskette in a personal computer system. A person of ordinary skill in the art, developing a method and device for recovering data in a data processing system would not have turned to methods of loading BIOS from a diskette in a personal computer system without impermissible hindsight.

Accordingly, a person of ordinary skill in the art would not have been motivated to combine Grawrock and Bealkowski in the manner suggested by the Examiner. For at least these additional exemplary reasons, claims 4, 5, and 11 are allowable.

VII. New Claims

In order to provide more varied protection, Applicant adds claims 12-15, which are patentable at least by virtue of their dependency on claim 1.

VIII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

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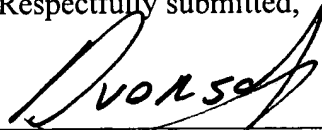
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Respectfully submitted,

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Date: August 4, 2006

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